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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/908,983 | 07/19/2001 | Gerald E. O'Shaughnessy | E32-003 | 6832 |

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ELMAN TECHNOLOGY LAW, P.C.
P. O. BOX 209
SWARTHMORE, PA 19081-0209

| EXAMINER | |
|---|---|
| ZHOU, TING | |
| **ART UNIT** | **PAPER NUMBER** |
| 2173 | 8 |

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/908,983 | O'SHAUGHNESSY ET AL. | |
| | Examiner | Art Unit | |
| | Ting Zhou | 2173 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-29 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-29 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 19 July 2001 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

BA HUYNH
PRIMARY EXAMINER

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 4.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because the following reference characters are not labeled in an appropriate descriptive manner: Note reference characters "122", "124", and "142" in Figure 1.

2. Applicant is required to submit a proposed drawing correction of the above noted deficiencies in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

### *Claim Objections*

3. Claims 7, 10-11 and 17-20 objected to because of the following informalities:

a. In claims 7 and 20, the use of "performing a file manipulation subroutines" on line 3 of the claims is grammatically incorrect. It is suggested that the phrase be changed to -- performing file manipulation subroutines --.

b. In claims 10-11, the use of "whether the message includes data includes multiple resulting messages" on line 4 of the claims is confusing. The meaning of this limitation is unclear.

c. In claims 17-19, the use of "in response said receiving" on line 6 of claims 17 and 18 and line 7 of claim 19 is grammatically incorrect. It is suggested that the phrase be changed to -- in response to said receiving --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-8, 11, 13, 17-26 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Moon et al. U.S. Patent 6,088,696.

Referring to claims 1 and 22, Moon et al. teach a method and computer program product comprising code for receiving communication files (receiving electronic mail), code for selecting a user-selected folder as the current folder, and code for associating at least a subset of the communications files with the current folder, including allocating the communications files with a file folder definition of the current folder, thereby providing a common folder structure which includes communications files in individual file folders containing related user files, as recited in column 4, lines 14-30 and further shown in Figure 10.

Referring to claim 2, Moon et al. teach accepting user input for file manipulation commands (such as the cut, copy, paste features), performing file manipulation subroutines corresponding to the user inputs (performing the features selected by the user to move data files to different directories within the messaging application) (column 2, lines 28-32 and column 5, lines 27-36), and associating file attachments with the user selected folders, and locating the file attachments in the respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (column 4, lines 57-66).

Referring to claim 3, Moon et al. teach the file attachments including attachment notes, file identification modifiers, and external file links, as recited in column 4, lines 57-61.

Referring to claim 4, Moon et al. teach placing the communications files with the current folder, thereby providing the common folder structure (placing the messages in the folder), as recited in column 1, lines 61-67 and column 2, lines 28-32.

Referring to claim 5, Moon et al. teach for each of a plurality of communication files, providing a control record in a directory location for indexing communications (index or tree view of directories shown in the top left portion of Figure 4), and for each of the plurality of

communication files, providing a communications record in the current folder for the communications file (contents of the directories shown in the top right portion of Figure 4), as recited in column 5, lines 14-21.

Referring to claim 6, Moon et al. teach providing a display of a folder tree, providing a display of contents of a current folder, and associating the subset of files with the current folder by allocating folder space in a file folder of the files to which the files are associated, as recited in column 5, lines 14-21 and further shown in Figures 4 and 10.

Referring to claim 7, Moon et al. teach accepting user inputs for file manipulation commands, performing file manipulation subroutines corresponding to the user inputs (performing the features selected by the user to move data files to different directories within the messaging application) (column 2, lines 28-32 and column 5, lines 27-36) and associating file attachments with selected ones of the files, and locating the file attachments in the respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (column 4, lines 57-66).

Referring to claim 8, Moon et al. teach transferring email communications to and from a host (sending and receiving mail to and from an external network) (column 4, lines 25-28) and manipulating data included in the email communications in accordance with the association of the subset of files with the folders and allocation of file attachments folder space (storing the received mail messages in designated folders according to its type or format) (column 4, lines 28-32), the transferring including determining whether the message is a record in a standardized file format, if the message is a record in the standardized format (determining if the mail is of an identifiable file type), presenting the record in an ordered manner, and determining whether the

message is a record in a predetermined format including association of file attachments, and permitting the user to assign the file attachments to a respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (if the file is of an identifiable type, determine its type and the storing it in the corresponding directory), as recited in column 1, lines 49-67 and column 4, lines 14-32. This is further shown in Figure 10.

Referring to claim 11, Moon et al. teach receiving a message, if the message is a record in the standardized format, determining whether the messages includes data including multiple resulting messages (i.e., whether it contains attachments), determining whether a first resulting message is text, if the first resulting message is text, adding the contents of the first resulting message as a sticker to all the other resulting messages, and deleting the first resulting message from the inbox (if the first resulting message, or attachment is a text file such a word processing data file for example, the system moves the message from the inbox to an appropriate directory folder) (column 4, lines 54-68).

Referring to claim 13, Moon et al. teach executing a find routine to locate a first file in a folder (for example, the "City Display" file in the "Personal Folder" shown in Figure 8), making a temporary list of extended file information records, determining if extended file information for the files is available, if the extended file information is available, displaying file information concerning the file (as can be seen from Figure 10, the system determines if there are extended information such as "Size", "Date", etc. associated with the located file, in this case, the "City Display" file, and if the information exists, it is shown on the display, as evidenced by reference characters "62" and "64), determining if a sticker note associated with the file is found and if the

sticker note is found, displaying the existence of the sticker note (reference character "152" in Figure 12), determining if a tag information associated with the file is found and if the tag information is found, displaying the existence of the tag information (reference character "144" in Figure 12) and repeating the sequence until no further files are found in the folder (As shown in Figures 11 and 12, the method provides a notification icon in the history list indicating that a particular voice phone call has been recorded; therefore, the icon serves as a tag to notify the user that a call has been recorded and can be replayed; furthermore, the user is able to associate a text note, or sticker note with the history list, or file of phone calls) (column 2, lines 46-58).

Referring to claim 17, Moon et al. teach tagging a file in response to a predetermined mouse click (for example, in response to the user clicking the "Cut" button, the associated file can be tagged and cut), providing a representation of the file in a mouse "drag" representation to follow the mouse until receiving another instance of the predetermined mouse click, and providing a "release mouse click" function in response to receiving another instance of the predetermined mouse click (for example, upon clicking the "Paste button", the associated file that was previously cut can be pasted to another directory), thereby permitting folder allocation without a requirement that the user hold a mouse button during a mouse "drag" operation (using the cut and paste button functions allows the files to be moved between folders without holding a mouse button), as recited in column 5, lines 52-67 and column 6, lines 9-23.

Referring to claim 18, Moon et al. teach tagging a file in response to a predetermined mouse click, providing a representation of the file in a mouse "drag" representation to follow the mouse until receiving another instance of the predetermined mouse click, providing a "release mouse click" function in response to receiving another instance of the predetermined mouse

click, thereby permitting folder allocation without a requirement that the user hold a mouse button during a mouse "drag" operation (column 5, lines 52-67 and column 6, lines 9-23), accepting user inputs for file manipulation commands, and performing a file manipulation subroutines corresponding to the user inputs (performing the features selected by the user to move data files to different directories within the messaging application) (column 2, lines 28-32 and column 5, lines 27-36).

Referring to claim 19, Moon et al. teach accepting user inputs for file manipulation by tagging a file in response to a predetermined mouse click, providing a representation of the file in a mouse "drag" representation to follow the mouse until receiving another instance of the predetermined mouse click, providing a "release mouse click" function in response to receiving another instance of the predetermined mouse click, thereby permitting folder allocation without a requirement that the user hold a mouse button during a mouse "drag" operation (column 5, lines 52-67 and column 6, lines 9-23), performing a file manipulation subroutines corresponding to the user inputs, selectively associating file attachments with selected ones of the files (for example, email messages with attachments), and locating the file attachments in the respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (storing files in the associated directory folder), and the association of the subset of the communications files with the current folder including allocating the communications files with a file folder definition of the current folder, thereby providing a common folder structure which includes communications files in individual file folders containing related user files (the incoming mail is sent through the mail filter, which recognizes the various types of incoming mail and places the mail and files in the corresponding directory

utilized by that application), as recited in column 4, lines 14-32 and 48-67 and further shown in Figure 10.

Referring to claim 20, Moon et al. teach accepting user inputs for file manipulation commands, performing file manipulation subroutines corresponding to the user inputs (column 2, lines 28-32 and column 5, lines 27-36), and associating file attachments with the user selected folders, and locating the file attachments in the respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (column 4, lines 57-66).

Referring to claim 21, Moon et al. teach transferring email communications to and from a host (sending and receiving mail to and from an external network) (column 4, lines 25-28) and manipulating data included in the email communications in accordance with the association of the subset of files with the folders and the allocation of file attachments folder space (storing the received mail messages in designated folders according to its type or format) (column 4, lines 28-32), the transfer including determining whether the message if a record in a standardized file format (determining if the mail is of an identifiable file type), if the message is a record in the standardized format, presenting the record in an ordered manner, and determining whether the message is a record in a predetermined format including association of file attachments, and permitting the user to assign the file attachments to a respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (if the file is of an identifiable type, determine its type and the storing it in the corresponding directory), as recited in column 1, lines 49-67 and column 4, lines 14-32. This is further shown in Figure 10.

Referring to claim 23, Moon et al. teach code for accepting user input for file manipulation commands (such as the cut, copy, paste features), performing file manipulation subroutines corresponding to the user inputs (performing the features selected by the user to move data files to different directories within the messaging application) (column 2, lines 28-32 and column 5, lines 27-36), wherein file attachments are associated with the user selected folders, and the file attachments are located in the respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (column 4, lines 57-66), wherein the file attachments include attachment notes, file identification modifiers, and external file links (column 4, lines 57-61).

Referring to claim 24, Moon et al. teach code for providing a control record in a directory location for indexing a plurality of communications files, by locating the control record in the current folder for the communications file, as shown by the index or tree view of directories shown in the top left portion of Figure 4 and the contents of the directories shown in the top right portion of Figure 4. This is further recited in column 5, lines 14-21.

Referring to claim 25, Moon et al. teach the communications files including email communications (column 4, lines 57-60), and code for transferring the email communications to and from a host (sending and receiving mail to and from an external network) (column 4, lines 25-28) and manipulating data included in the email communications in accordance with the association of the subset of files with the folders and the allocation of file attachments folder space (storing the received mail messages in designated folders according to its type or format) (column 4, lines 28-32), the transfer including determining whether the message is a record in a standardized file format (determining if the mail is of an identifiable file type) and if the message

is a record in the standardized format, presenting the record in a ordered manner, and determining whether the message is a record in a predetermined format including association of file attachments, and permitting the user to assign the file attachments to a respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (if the file is of an identifiable type, determine its type and the storing it in the corresponding directory), as recited in column 1, lines 49-67 and column 4, lines 14-32. This is further shown in Figure 10.

Referring to claim 26, Moon et al. teach receiving a message, if the message is a record in the standardized format, determining whether the messages includes data including multiple resulting messages (i.e., whether it contains attachments), determining whether a first resulting message is text, if the first resulting message is text, adding the contents of the first resulting message as a sticker to all the other resulting messages, and deleting the first resulting message from the inbox (if the first resulting message, or attachment is a text file such a word processing data file for example, the system moves the message from the inbox to an appropriate directory folder) (column 4, lines 54-68).

Referring to claim 28, Moon et al. teach code for tagging a file in response to a predetermined mouse click (for example, in response to the user clicking the "Cut" button, the associated file can be tagged and cut), providing a representation of the file in a mouse "drag" representation to follow the mouse until receiving another instance of the predetermined muse click, and providing a "release mouse click" function in response to receiving another instance of the predetermined mouse click (for example, upon clicking the "Paste button", the associated file that was previously cut can be pasted to another directory), thereby permitting folder allocation

without a requirement that the user hold a mouse button during a mouse "drag" operation (the use of the cut and paste buttons allows the files to be moved between folders without holding a mouse button), as recited in column 5, lines 52-67 and column 6, lines 9-23.

Referring to claim 29, Moon et al. teach code for performing a file manipulation subroutines corresponding to the user inputs, selectively associating file attachments with selected ones of the files (for example, email messages with attachments), and locating the file attachments in the respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (storing files in the associated directory folder), and the association of the subset of the communications files with the current folder including allocating the communications files with a file folder definition of the current folder, thereby providing a common folder structure which includes communications files in individual file folders containing related user files (the incoming mail is sent through the mail filter, which recognizes the various types of incoming mail and places the mail and files in the corresponding directory utilized by that application), as recited in column 4, lines 14-32 and 48-67 and further shown in Figure 10.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 9-10 and 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moon et al. U.S. Patent 6,088,696., as applied to the claims above.

Referring to claim 9, Moon et al. teach receiving a message, if the message is a record in a standardized format, determining whether the message is a multipart message (i.e., whether it contains attachments) and if it is a multipart message, determining what type of message it is and routing the messages to and displaying it in the appropriate directory folders according to its determined type, as recited in column 4, lines 14-32 and 54-67. Therefore, it would have been obvious to one of ordinary skill in the art that the steps used by Moon et al. to determine what type of message it is and routing the messages to and displaying it in the appropriate directory folders according to its determined type could include the steps recited in claim 9. One would have been motivated to make such a combination in order to have an ordered way of determining message types and presenting it to the user.

Referring to claim 10, Moon et al. teach receiving a message, if the message is a record in the standardized format, determining whether the messages includes data including multiple resulting messages (i.e., whether it contains attachments), determining whether a first resulting message is text, if the first resulting message is text, adding the contents of the first resulting message as a sticker to all the other resulting messages, and deleting the first resulting message from the inbox (if the first resulting message, or attachment is a text file such a word processing data file for example, the system moves the message from the inbox to an appropriate directory folder) (column 4, lines 54-68).

Referring to claim 14, Moon et al. teach displaying tag information associated with a file, as applied to claim 13 above. Although Moon et al. does not explicitly teach presenting the tag information as a color code, teachings of color coding information on a display is well know in the art. Therefore, it would have been obvious to one of ordinary skill in the art, to display the tag information taught by Moon et al. in a color-coded format. One would have been motivated to make such a combination in order to allow users to be able to easily distinguish information on a display.

6. Claim 12 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Moon et al. U.S. Patent 6,088,696, as applied to the claims above, and further in view of Beletic et al. U.S. Patent 5706211.

Referring to claim 12, Moon et al. teach all of the limitations as applied to the claims above. Specifically, Moon et al. teach receiving a message, if the message is a record in the standardized format, determining whether the message includes parts which are not part of a multipart message (column 4, lines 54-68). However, Moon et al. fail to teach determining a form of encoding for the message parts, and decoding the message parts according to the form of encoding. Beletic et al. teach a message communications system similar to that of Moon et al. In addition , Beletic et al. further teach encoding and decoding messages, as recited in column 6, lines 44-45. It would have been obvious to one of ordinary skill, having the teachings of Moon et al. and Beletic et al. before him at the time the invention was made, to modify the mailing system that doubles as a filing system of Moon et al. to include the encoding and decoding of messages, as taught by Beletic et al. It would have been advantageous for one to utilize such a

combination in order to provide security in sending and receiving messages, ensuring that only the intended recipient is able to view the message.

7. Claims 15-16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moon et al. U.S. Patent 6,088,696, as applied to the claims above, and further in view of Venkatraman et al. U.S. Patent 6,014,688.

Referring to claims 15 and 27, Moon et al. teach all of the limitations as applied to the claims above. Specifically, Moon et al. teach transferring email communications to and from a host (sending and receiving mail to and from an external network) (column 4, lines 25-28) and manipulating data included in the email communications in accordance with the association of the subset of files with the folders and the allocation of file attachments folder space (storing the received mail messages in designated folders according to its type or format) (column 4, lines 28-32) and if the transfer is a receive operation, permitting the user to assign the file attachments to a respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (if incoming mail if received, the messages can be placed, or allocated to specific folder directories) (column 4, lines 28-32). However, Moon et al. fail to teach determining if the recipient is tagged for encryption and if the recipient is tagged for encryption, sending the file in encrypted form. Venkatraman et al. teach a method for transferring email messaged to and from a host similar to that of Moon et al. In addition, Venkatraman et al. further teach determining if the message is encrypted in sending an email and sending the mail in the encrypted form if it is (column 4, lines 61-67 and column 5, lines 1-2). It would have been obvious to one of ordinary skill in the art, having the teachings of Moon et al.

and Venkatraman et al. before him at the time the invention was made to modify the mailing system that doubles as a filing system of Moon et al. to include the encryption of outgoing messages, as taught by Venkatraman et al. It would have been advantageous for one to utilize such a combination in order to provide more security for personal and confidential material that may be sent via electronic messages.

Referring to claim 16, Moon et al. teach accepting user inputs for file manipulation commands, performing file manipulation subroutines corresponding to the user inputs (performing the features selected by the user to move data files to different directories within the messaging application) (column 2, lines 28-32 and column 5, lines 27-36) and associating file attachments with selected ones of the files, and locating the file attachments in the respective folder by allocating the file attachments folder space in a file folder of the files to which the file attachments are associated (column 4, lines 57-66).

8. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar rule-based methods for receiving and filing messages.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (703)305-0328. The examiner can normally be reached on Monday - Friday 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 4, 2004

BA HUYNH
PRIMARY EXAMINER